

3/7/03

George:

This application was published in the OG on 9/10/02. Therefore, a first action was due as soon as possible on or after 11/11/02. Please note the enclosed reissue checklist and instructions for its use. **There are rule changes that went into effect on 11/7/00 regarding reissues, and the new (5/13/02) checklist reflects those rule changes.** (Under the new rules, you CAN do a restriction in a reissue case under certain circumstances; see me for details!) . If you review the checklist, you will see that certain housekeeping items are required, such as ordering the patented file and having a litigation search done at the STIC, bldg 3-4, 2nd floor or in the EIC in this bldg, 2nd floor. I believe that you can e-mail a request for the litigation report to STIC or the EIC and they will e-mail the report back to you. Reissues are automatically stayed during pending litigation, with certain exceptions. See MPEP 1442.02.

**This case is a broadening reissue. You will have to do a recapture analysis, which means that you certainly have to have the patented file.**

The following items need attention in your first action:

The oath or declaration is defective for failing to state that "all errors being corrected in the reissue application up to the time of filing of the declaration under this paragraph arose without deceptive intent." See 37 CFR 1.175(a)(2), and MPEP 1414. In addition, the oath states two errors: claiming temperature sensing, and claiming temperature sensing of the by-product of the abrading process. I don't see that the new claims deal with anything other than the second error. Your first action should raise these problems, and require a supplemental oath/declaration.

All other reissue formalities are currently satisfied, and maintenance fees aren't due until 6/28/03 (3.5 years from issue date) and can be paid on or before 12/28/03 (4 years from issue date).

Procedurally, I will ask you to retain the checklist and the patented file in your Office, because the patented file must be forwarded with the allowed application file and I will need the checklist then too.

If you have any questions, please get in touch with me at your convenience. Again, note that new reissue rules went into effect on 11/7/00, and some (but certainly not all) may have an effect on the examination as applying to responses filed on or after 11/7/00.

Thanks,

Steve Marcus